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EXAMINER
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POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/026,247

Applicant(s)

COVINGTON ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-69 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/02.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 26, 27, and 37 are provisionally rejected under the judicially created doctrine of double patenting over Claims 1, 21, 30, 33, and 43 of copending Application No 09/705,252.**

This is a provisional double patenting rejection since the conflicting claims have not yet been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject

matter, as follows: creating a wish list by scanning items with a handheld device, transferring stored item information in the handheld devices internal memory to a database, providing a web site that allows buyers to search and view the wish list, notifying buyers of the existence of the wish list.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 3. Claims 26, 32, and 33 are rejected under 35 USC 102(e) as being anticipated by LeRoy (patent number 5,970,474).**

LeRoy teaches all the limitations of Claims 26, 32, and 33. For example, LeRoy discloses a system and method of shopping in a physical retail location and online, creating a wish list by a registrant who may either scan product selections while physically in a store or create the wish list online (e.g. from

home), and customers making actual purchases on behalf of the registrant based on the registered wish list (see at least abstract; col. 1, line 13 through col. 2, line 10). LeRoy further discloses:

- Providing a database and a handheld data entry unit including internal memory; Database coupled to a computer server: (see at least Fig. 1 (15, 30); col. 3, lines 23-34; col. 4, line 62; col. 7, lines 35-57).
- Storing item information (in handheld unit memory; Handheld unit with internal memory to scan physical items: (see at least col. 5, lines 52-55).
- Uploading lists from the internal memory of the handheld unit to the database: (see at least Fig. 1 (15); col. 6, lines 39-67).
- Creating a wish list of items; storing wish list in database: registrant selects desired items (please note examiner's interpretation: creating a list of desired items is a wish list); associates scanned items with registry ID; registrant login requiring username and password (see at least Fig. 2 (R2); col. 2, lines 19-22; col. 7, lines 42-44 col. 9, lines 53-61).
- Providing a web site that allows a buyer to search for an view the wish list: registrant uses a web site to create one or more wish lists (please note examiner's interpretation: the registrant creates one or more lists of desired items to be purchased by others (e.g. wedding, birthday) (see at least col. 1, lines 14-17; col. 6, lines 27-33).

- Associating a member with scanned items: customer (please note: “member” is defined by Applicant as a buyer) scans items on a registrant’s wish list (see at least col. 5, line 10 through col. 6, line 67).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-6, 8-10, 12, 13, 15, 19-21, 24, 25, 58-61, 63-65, and 67-69 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106), further in view of Official Notice (regarding well within the skill hereinafter referred to as “ON1”).**

LeRoy teaches a system and method of shopping in a physical retail location and online, creating a wish list by a registrant who may either scan product selections while physically in a store or create the wish list online (e.g. from home), and customers making actual purchases on behalf of the registrant based on the registered wish list (see at least abstract; col. 1, line 13 through col. 2, line 10). LeRoy further teaches:

- Providing a database and a handheld data entry unit including internal memory; Database coupled to a computer server: (see at least Fig. 1 (15, 30); col. 3, lines 23-34; col. 4, line 62; col. 7, lines 35-57).
- Storing item information (in handheld unit memory; Handheld unit with internal memory to scan physical items: (see at least col. 5, lines 52-55).
- Uploading lists from the internal memory of the handheld unit to the database: (see at least Fig. 1 (15); col. 6, lines 39-67).
- Creating a wish list of items; storing wish list in database: registrant selects desired items (please note examiner's interpretation: creating a list of desired items is a wish list); associates scanned items with registry ID; registrant login requiring username and password (see at least Fig. 2 (R2); col. 2, lines 19-22; col. 7, lines 42-44 col. 9, lines 53-61).
- Providing a web site that allows a buyer to search for an view the wish list: registrant uses a web site to create one or more wish lists (please note examiner's interpretation: the registrant creates one or more lists of desired items to be purchased by others (e.g. wedding, birthday). The mere act of exposing the wish list to others via the gift registry system converts the wish list into a buy list from the perspective of others viewing the information who want to use the list to buy one or more items for the registrant) (see at least col. 1, lines 14-17; col. 6, lines 27-33).

LeRoy teaches all the above as noted under the 103(a) rejection and teaches

a) a registrant creating and storing a wish list in an online gift registry, b) buyers

purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a buy list for buyers to use on behalf of the registrant, but does not specifically disclose creating an access mechanism that notifies selected buyers of the existence of one or more of the wish list. Robertson teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

LeRoy teaches all the above as noted under the 103(a) rejection and teaches but does not disclose associating a plurality of member identification numbers with one registered user. Robertson teaches the registrant creating a distribution list containing a plurality of individuals associated with the registrant, and using email to notifying each individual on a distribution list (please note examiner's interpretation: email address of each individual on the distribution list represents a number that identifies the individual) (see at least Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at



time of the invention to modify the method of LeRoy to implement a distribution list containing individuals associated with a registrant as taught by Robertson, in order to associate a plurality of individuals with a user who would be interested in the user's wish list, and thereby generate sales for the online service.

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) scanning items with a portable scanner in the physical retailer that stores registrant gift registry selections in the portable scanner, and b) registrants physically moving about a store to make selections, but do not disclose registering after scanning items. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy and Robertson to disclose registering after scanning, since it is well within the skill to ascertain that accepted retail business practices allow potential gift registry registrants to physically collect item information in a store prior to registering, in order to allow a potential registrant an opportunity to determine whether the retailer's goods are suitable to the potential registrant's wish list.

- 5. Claims 7 and 62 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON1 (regarding well within the skill), as applied to Claims 1 and 58, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON2").**

LeRoy, Robertson, and ON1 teach all the above as noted under the 103(a) rejection and teaches a) an item stock number and the division (please note examiner's interpretation: organizational unit of a store) associated with the stock number, b) the system serving multiple retail locations, c) buying at a store location different from the store the item was scanned, but does specifically disclose determining or identifying the physical retailer or location. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy, Robertson, and ON1 to disclose a store location for the retailer associated with an item stock number, since it is well within the skill to ascertain that buyers desiring to purchase an item from the wish list need to know where the item can be found, and thereby increase sales because buyers can locate the item(s) to purchase.

- 6. Claims 11, 14, and 66 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON1 (regarding well within the skill), as applied to Claims 1, 8, and 58, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON3").**

LeRoy, Robertson, and ON1 teach all the above as noted under the 103(a) rejection and teach a) requiring the user to use a gift registrant ID and password to access a secured user profile information and wish lists, and b) buyer's accessing a user's wish list using the user gift registrant ID or name search

(please note examiner's interpretation: requiring a gift registrant ID or registrant name search implements a level of secure access), but do not disclose requiring the buyer to enter a password to access a private wish list. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and ON1 to disclose the buyer accessing a private wish list using a password, since it is well within the skill to ascertain that requiring a password is another implementation of secure access.

- 7. Claim 16 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON1 (regarding well within the skill), as applied to Claim 15, further in view of Schwartz et al. (patent number 5,913,032 hereinafter referred to as "Schwartz").**

LeRoy, Robertson, and ON1 teach all the above as noted under the 103(a) rejection and teach sending emails to buyers on a distribution list, but do not disclose choosing buyers from an address book. Schwartz teaches electronic address books as simplifying the email process, and further teaches choosing email recipients from an address book to populate distribution lists (see at least abstract; col. 13, line 32 through col. 14, line 33). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and ON1 to choose email recipients from an address book as taught

by Schwartz, in order to simplify email processing by the registrant, and thereby attract registrants to the service.

- 8. Claim 17 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON1 (regarding well within the skill), as applied to Claim 15, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON4").**

LeRoy, Robertson, and ON1 teach all the above as noted under the 103(a) rejection and teach or suggest a) issuing an email notification to the user including a embedded link that takes the user directly to preferred web site (please note: a hyperlink) (see at least Fig. 7 (190); col. 15, lines 19-25), b) issuing an email to a buyer on a user's distribution list, and c) requiring a buyer to use a password to access a private wish list, but do not disclose embedding the password in a hyperlink. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and ON1 to disclose embedding the password in a hyperlink, since it is well within the skill to ascertain the service wants the notified buyer to go directly to the user's wish list in order to make a purchase from the wish list, and thereby provide the buyer a shopping convenience.

- 9. Claim 18 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON1 (regarding well within the skill), as applied to Claim 1, further in view of Wireless Data News (PTO-892, Item: U hereinafter referred to as "WDA").**

LeRoy, Robertson, and ON1 teach all the above as noted under the 103(a) rejection and teach wireless scanning of items, but do not disclose other input devices comprising a wireless telephone and a personal digital assistant. WDA teaches a) a wireless handheld scanning terminal, b) the Wireless Application Protocol (WAP) used for mobile communications and accessing Internet services using cellular phones, and c) a handheld computing device (e.g. palm-size device with keyboard and screen to help deaf or hard-of-hearing users communicate interactively) (please note examiner's interpretation: a PDA providing the user a computing convenience) (U: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of LeRoy, Robertson, and ON1 to provide a group of input devices as taught by WDA, in order to accommodate a variety of input devices, and thereby provide a shopping convenience.

- 10. Claims 22 and 23 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), ON1 (regarding well within the skill), as applied to Claim**

**1, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON5").**

LeRoy, Robertson, and ON1 teach all the above as noted under the 103(a) rejection and teach a) retailers providing merchandise for gift registry buyers, b) organizing wish lists by events (e.g. birthdays), and c) using icon tabs to organized information by events, but do not specifically disclose wish lists organized by specific retailers. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of LeRoy, Robertson, and ON1 to organize wish lists by specific retailers, since it is well within the skill to ascertain that specific retailers promote events with special pricing (e.g. Washington/Lincoln's birthday), and thereby provide incentives to organize wish lists based on specific retailers.

**11. Claims 27 and 34 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106).**

LeRoy teaches all the above as noted under the 102(e) rejection and teaches a) a registrant creating and storing a wish list in an online gift registry, b) buyers purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a list for buyers to use on behalf of the registrant, but does not specifically disclose creating an access mechanism that notifies selected buyers of the existence of one or more of the wish list. Robertson

teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

LeRoy teaches all the above as noted under the 102(e) rejection and teaches associating a buyer with scanned items, but does not disclose associating a plurality of member identification numbers with one registered user. Robertson teaches all the above as noted under the 103(a) rejection and teaches the registrant creating a distribution list containing a plurality of individuals associated with the registrant, and further teaches using email to notify each individual on a distribution list (please note examiner's interpretation: email address of each individual on the distribution list represents a number that identifies the individual) (see at least Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to implement a distribution list containing individuals associated with a registrant as taught by Robertson, in order to associate a plurality of

individuals with a user who would be interested in the user's wish list, and thereby generate sales for the online service.

- 12. Claim 28 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Official Notice (regarding well within the skill hereinafter referred to as "ON1").**

LeRoy teaches all the above as noted under the 102(e) rejection and teaches a) scanning items with a portable scanner in the physical retailer that stores registrant gift registry selections in the portable scanner, and b) registrants physically moving about a store to make selections, but do not disclose registering after scanning items. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy to disclose registering after scanning, since it is well within the skill to ascertain that accepted retail business practices allow potential gift registry registrants to physically collect item information in a store prior to registering for one or more wish lists, in order to allow a potential registrant an opportunity to determine whether the unassigned retailer's goods are suitable to the potential registrant as wish list items.

- 13. Claims 29-31 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Official Notice (regarding well within the skill hereinafter referred to as "ON2").**



LeRoy teaches all the above as noted under the 102(e) rejection and teaches a) an item stock number and the division (please note examiner's interpretation: organizational unit of a store) associated with the stock number, b) the system serving multiple retail locations, c) buying at a store location different from the store the item was scanned, but does specifically disclose determining or identifying the physical retailer or location. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to disclose a store location for the retailer associated with an item stock number, since it is well within the skill to ascertain that buyers desiring to purchase an item from the wish list need to know where the item can be found, and thereby increase sales because buyers can locate the item(s) to purchase.

- 14. Claim 35 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106), as applied to Claim 26, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON3").**

LeRoy teaches all the above as noted under the 102(e) rejection and teaches a) a registrant creating and storing a wish list in an online gift registry, b) buyers purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a buy list for buyers to use on behalf of the registrant, but does not specifically disclose creating an access mechanism that notifies

selected buyers of the existence of one or more of the wish list. Robertson teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

LeRoy teaches all the above as noted under the 102(e) rejection and teaches but does not disclose associating a plurality of member identification numbers with one registered user. Robertson teaches all the above as noted under the 103(a) rejection and teaches the registrant creating a distribution list containing a plurality of individuals associated with the registrant, and further teaches using email to notify each individual on a distribution list (please note examiner's interpretation: email address of each individual on the distribution list represents a number that identifies the individual) (see at least Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to implement a distribution list containing individuals associated with a registrant as taught by Robertson, in

order to associate a plurality of individuals with a user who would be interested in the user's wish list, and thereby generate sales for the online service.

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) requiring the user to use a gift registrant ID and password to access a secured user profile information and wish lists, and b) buyer's accessing a user's wish list using the user gift registrant ID or name search (please note examiner's interpretation: requiring a gift registrant ID or registrant name search implements a level of secure access), but do not disclose requiring the buyer to enter a password to access a private wish list. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose the buyer accessing a private wish list using a password, since it is well within the skill to ascertain that requiring a password is another implementation of secure access.

- 15. Claim 36 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON3 (regarding well within the skill), as applied to Claim 26, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON4").**

LeRoy, Robertson, and ON3 teach all the above as noted under the 103(a) rejection and teach or suggest a) issuing an email notification to the user including a embedded link that takes the user directly to preferred web site (please note: a hyperlink) (see at least Fig. 7 (190); col. 15, lines 19-25), b)

issuing an email to a buyer on a user's distribution list, and c) requiring a buyer to use a password to access a private wish list, but do not disclose embedding the password in a hyperlink. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and ON3 disclose embedding the password in a hyperlink, since it is well within the skill to ascertain the service wants the notified buyer to go directly to the user's wish list in order to make a purchase from the wish list, and thereby provide the buyer a shopping convenience.

**16. Claims 37, 38, 41-43, 46-48, 51-53, 55, and 56 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106).**

LeRoy teaches a system and method of shopping in a physical retail location and online, creating a wish list by a registrant who may either scan product selections while physically in a store or create the wish list online (e.g. from home), and customers making actual purchases on behalf of the registrant based on the registered wish list (see at least abstract; col. 1, line 13 through col. 2, line 10). LeRoy further teaches:

- Providing a database and a handheld data entry unit including internal memory; Database coupled to a computer server; (see at least Fig. 1 (15, 30); col. 3, lines 23-34; col. 4, line 62; col. 7, lines 35-57).

- Storing item information (in handheld unit memory; Handheld unit with internal memory to scan physical items: (see at least col. 5, lines 52-55).
- Uploading lists from the internal memory of the handheld unit to the database: (see at least Fig. 1 (15); col. 6, lines 39-67).
- Creating a wish list of items; storing wish list in database: registrant selects desired items (please note examiner's interpretation: creating a list of desired items is a wish list); associates scanned items with registry ID; registrant login requiring username and password (see at least Fig. 2 (R2); col. 2, lines 19-22; col. 7, lines 42-44 col. 9, lines 53-61).
- Providing a web site that allows a buyer to search for an view the wish list: registrant uses a web site to create one or more wish lists (please note examiner's interpretation: the registrant creates one or more lists of desired items to be purchased by others (e.g. wedding, birthday). The mere act of exposing the wish list to others via the gift registry system converts the wish list into a buy list from the perspective of others viewing the information who want to use the list to buy one or more items for the registrant) (see at least col. 1, lines 14-17; col. 6, lines 27-33).

LeRoy teaches all the above as noted under the 103(a) rejection and teaches a) a registrant creating and storing a wish list in an online gift registry, b) buyers purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a buy list for buyers to use on behalf of the registrant, but

does not specifically disclose creating an access mechanism that notifies selected buyers of the existence of one or more of the wish list. Robertson teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

LeRoy teaches all the above as noted under the 103(a) rejection and teaches but does not disclose associating a plurality of member identification numbers with one registered user. Robertson teaches all the above as noted under the 103(a) rejection and teaches the registrant creating a distribution list containing a plurality of individuals associated with the registrant, and further teaches using email to notify each individual on a distribution list (please note examiner's interpretation: email address of each individual on the distribution list represents a number that identifies the individual) (see at least Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to implement a distribution list containing individuals associated with a registrant as taught by Robertson, in

order to associate a plurality of individuals with a user who would be interested in the user's wish list, and thereby generate sales for the online service.

- 17. Claims 39 and 49 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent number 6,609,106), as applied to Claims 37 and 46, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON1").**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) scanning items with a portable scanner in the physical retailer that stores registrant gift registry selections in the portable scanner, and b) registrants physically moving about a store to make selections, but do not disclose registering after scanning items. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy and Robertson to disclose registering after scanning, since it is well within the skill to ascertain that accepted retail business practices allow potential gift registry registrants to physically collect item information in a store prior to registering, in order to allow a potential registrant an opportunity to determine whether the retailer's goods are suitable to the potential registrant.

- 18. Claims 40 and 50 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent**

**number 6,609,106), as applied to Claims 37 and 46, further in view of Official Notice (regarding well within the skill hereinafter referred to as “ON2”).**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teaches a) an item stock number and the division (please note examiner's interpretation: organizational unit of a store) associated with the stock number, b) the system serving multiple retail locations, c) buying at a store location different from the store the item was scanned, but does specifically disclose determining or identifying the physical retailer or location. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy and Robertson to disclose a store location for the retailer associated with an item stock number, since it is well within the skill to ascertain that buyers desiring to purchase an item from the wish list need to know where the item can be found, and thereby increase sales because buyers can locate the item(s) to purchase.

- 19. Claim 44 and 54 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106), as applied to Claims 37, and 46, further in view of Official Notice (regarding well within the skill hereinafter referred to as “ON3”).**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) requiring the user to use a gift registrant ID and password to access



a secured user profile information and wish lists, and b) buyer's accessing a user's wish list using the user gift registrant ID or name search (please note examiner's interpretation: requiring a gift registrant ID or registrant name search implements a level of secure access), but do not disclose requiring the buyer to enter a password to access a private wish list. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy and Robertson to disclose the buyer accessing a private wish list using a password, since it is well within the skill to ascertain that requiring a password is another implementation of secure access.

- 20. Claims 45 and 57 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), Robertson (patent number 6,609,106), and ON3 (regarding well within the skill), as applied to Claims 44 and 55, further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON4").**

LeRoy, Robertson, and ON3 teach all the above as noted under the 103(a) rejection and teach or suggest a) issuing an email notification to the user including a embedded link that takes the user directly to preferred web site (please note: a hyperlink) (see at least Fig. 7 (190); col. 15, lines 19-25), b) issuing an email to a buyer on a user's distribution list, and c) requiring a buyer to use a password to access a private wish list, but do not disclose embedding the password in a hyperlink. It would have been obvious to one of ordinary skill in the

art at time of the invention to modify LeRoy, Robertson, and ON3 to disclose embedding the password in a hyperlink, since it is well within the skill to ascertain the service wants the notified buyer to go directly to the user's wish list in order to make a purchase from the wish list, and thereby provide the buyer a shopping convenience.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond  
Primary Patent Examiner  
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